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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/080,986	02/22/2002	Ronald A. Schachar	PRES06-00251	9951
7590	05/04/2004		EXAMINER	
Docket Clerk P.O. Drawer 800889 Dallas, TX 75380			PANTUCK, BRADFORD C	
			ART UNIT	PAPER NUMBER
			3731	
DATE MAILED: 05/04/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/080,986

Applicant(s)

SCHACHAR ET AL.

Examiner

Bradford C Pantuck

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03-12-2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 9-18 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5-8 is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Species 1: Surgical blade and method of using (Claims 1-8: Figure 40) in Paper No. 03-12-2004 is acknowledged.
2. Claims 9-18 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 03-12-2004.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a) because they fail to show in Figure 41 how string-like connector 4200 and prosthesis 200 are attached to the cutting blade 4020 as described in the specification on page 50 line 15 to page 51 line 13. This makes it difficult to understand how the blade pulls the prosthesis into the pocket. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,342,377 to Lazerson. Regarding Claim 1, Lazerson discloses an instrument having a drive shaft (30), which is rotatably connected to a support arm (54) [see Fig. 53; Column 5, lines 3-8], which is detachably coupled to a curved cutting blade (66) [see Fig. 4]. The reader knows that the blade is detachable from the support arm in the embodiment shown in Figure 4, because Lazerson singles this embodiment out as being different from the embodiments shown in Figures 11 and 12, which have their blades and support arm “forged...as a unitary piece” [Column 4, lines 35-37].
5. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 3,609,864 to Bassett. Regarding Claim 1, Bassett discloses a rotatable support arm, comprising elements 20 and 21, as shown in Figure 2. This support arm is rotatable relative to drive shaft (30) []. Further, this support arm is generally rotatable: i.e., the user can spin (rotate) *the whole device* like a top. Finally, this support arm rotates relative to the handle (shell 28) of the device, when the user rotates handle 31 (thus turning the drive shaft 30) [Column 4, lines 4-10; Fig. 1]. A curved cutting blade (24) is detachable coupled to a second end of the rotatable support arm (20/21). This cutting blade (24) is capable of being rotated in any way the user desires, including rotating the blade through body tissue such as scleral tissue.

6. Regarding Claim 2, the cutting blade is capable of making an incision having the specifications outlined by the Applicant in Claim 2. Bassett's invention is intended for surgical uses as it is entitled "SURGICAL BLADE HANDLE." The specifications of the cut size are more dependent on the skill of the surgeon than on the mechanical features of the invention. In apparatus claims more weight is given to the mechanical features claimed than on a method of using the device.
7. Regarding Claim 3, Bassett discloses a surgical blade having an extension (proximal end of blade) having a portion (inner portion of the proximal end of the blade) that has an aperture "keyhole slot 25" [see Figure 1].

Allowable Subject Matter

8. Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
9. Claims 5-8 are allowed.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 4,753,655 to Hecht

U.S. Patent No. 5,431,671 to Nallakrishnan

U.S. Patent No. 3,922,784 to Prince et al.

U.S. Patent No. 4,672,964 to Dee et al.

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Publication No. US 2002/0116062 to Portney

U.S. Patent No. 5,215,104 to Steinert

U.S. Patent No. 6,602,266 to Loomas

U.S. Patent No. 5,423,841 to Kornefeld

U.S. Patent No. 6,033,437 A to Perry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradford C Pantuck whose telephone number is (703) 305-8621. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J Milano can be reached on (703) 308-2496. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Michael Milano
Supervisory Patent Examiner
Art Unit 3731

BCP
BCP

April 30, 2004